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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,000	11/09/2000	Mark A. Hollar	200	6001

31665 7590 02/17/2004

PATENT DEPARTMENT  
MACROVISION CORPORATION  
2830 DE LA CRUZ BLVD.  
SANTA CLARA, CA 95050

EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/711,000

Applicant(s)

HOLLAR, MARK A.

Examiner

Pierre E. Elisca

Art Unit

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/08/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This Office action is in response to Applicant's Response filed on 12/08/2003.
2. Claims 1-73 are pending.
3. The rejection to claims 1-73 under 35 U.S.C. 102 (e) as being anticipated by Wonfor et al. (U.S. Pat. No. 6,381,747) and 35 U.S.C. 102 (e) as being anticipated by Sims, III (U.S. Pat. No. 6,438,235) as set forth in the Office action mailed on 09/09/2003 is maintained.

## RESPONSE TO ARGUMENTS

4. Applicant's arguments filed on 12/08/2003 have been fully considered but they are not persuasive.

## REMARKS

5. In response to Applicant's arguments, Applicant argues that the prior art of record (Wonfor and Sims III) fail to disclose:
  - a. Applicant argues that Applicant's claimed invention does not claim a copy protection system. However, the Examiner respectfully disagrees since Wonfor discloses a

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method/system of providing copy protection of video analog and digital signals, which is readable as a method for distributing protected material.

b. "ascertaining terms for providing material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient". As noted in the Office action mailed on 09/09/2003, Wonfor discloses this limitation in the abstract, col 4, lines 21-67, specifically wherein said the right holders authorize video service providers to apply copy protection to the program material. Also, see., Sims III, col 2, lines 21-67, wherein said under the terms of a license agreement.

c. "providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms". Based upon the rejection mailed on 09/09/2003, it is believed that Wonfor discloses this limitation in the abstract, col 5, lines 30-67, col 7, lines 53-67, col 8, lines 18-45, col 8, lines 1-8. see., Sims II, col 2, lines 21-67, col 3, lines 7-45, col 8, lines 1-8.

d. "obtaining said information of unauthorized copying from a database". However, the Examiner respectfully disagrees because Wonfor discloses this limitation in col 5, lines 7-65, specifically wherein said obtain a taped copy 26 without authorization, the unauthorized copy will be degraded to the degree that it is un-watchable.

## CONCLUSION

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

February 10, 2004